

Remarks

This is a Response to the Official Action dated March 18, 2005.

Claims 1-2, 7 and 11-12 are currently pending in the Application, Claim 7 is presently canceled without prejudice and Claims 13-25 are newly presented herein.

Claims 1-2, 7 and 11-12

This response amends Claims 1-2 and 11 to clarify the scope of the invention and cancels Claim 7 without prejudice.

New Claims

This response presents new claims 13-25. The new claims are used to broaden the scope of the invention and are **not** offered in response to the Examiner's rejections. Support for the new Claims 13-25 can be found in Figures 2 and 4 of the specification and associated disclosure. No new matter has been added.

Specification Objections

The Examiner objects to the specification for failing to provide proper antecedent basis for the claimed subject matter. Specifically, the Examiner objects to the specification for not reciting "partial error signal" and "partial periodic signal" as recited in the claims.

Claims 1-2 and 11-12 have been amended to remove the terms "partial error signal" and "partial periodic signal." Hence, the specification provides proper antecedent basis for the currently claimed subject matter and Applicants request that the objection be withdrawn.

Claim Objections

The Examiner objects to Claim 7 for reciting "The for servo controlling . . ." Claim 7 has been canceled without prejudice and Applicants respectfully request that the objection be withdrawn.

35 U.S.C. §112, first paragraph, rejection

Claims 1-2 and 11-12 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. The Examiner asserts that a duty control unit 33 disclosed in the specification should be recited in claims.

Applicants submit that the Examiner has **not** established a *prima facie* case of enablement requirement for the claims rejected under 35 U.S.C. §112, first paragraph. Applicants note that “when rejecting a claim under the enablement requirement of Section 112, the [Patent Office] bears an initial burden of setting forth a reasonable explanation as to why it believes that the scope of protection provided by the claim is not adequately enabled by the description of the invention provided in the specification of the application.” See *In re Wright*, 999 F.2d 1557. Applicants submit that the Examiner has not met this initial burden.

Applicants submit that the Examiner has merely concluded that the claims are incomplete for not reciting the duty control unit 33 without providing any basis for such a conclusion. As such, it appears that the Examiner has overlooked, by way of an example and not of limitation, Figures 2 and 4 of the specification. Contrary to the Examiner’s conclusion, embodiment shown in Figures 2 and 4 do not disclose the duty control unit 33.

Applicants submit that persons skilled in the art would recognize in the Figures 2 and 4 a description of the invention defined by the claims without the duty control signal 33. If the Examiner is of a different opinion, Applicants respectfully request that the Examiner present evidence or reasons “why … [he] believes that the scope of protection provided by the claim is not adequately enabled by the description of the invention provided in the specification of the application” at least based on the Figures 2 and 4 disclosed above.

Hence, Applicants respectfully request that the 35 U.S.C. §112, first paragraph, rejection be withdrawn.

35 U.S.C. §112, second paragraph, rejection

Claims 1-2, 7 and 11-12 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. According to the Examiner Claims 1 and 11 refer to “a partial error signal” even though there is no positive support for a source for such a “partial error signal.” Claims 1 and 11 have been amended by deleting any reference to the objected “partial error signal.” Hence, Applicants request that the rejection be withdrawn.

Similarly, the Examiner further objects to Claim 7 for reciting a “partial periodic signal.” Applicants submit that Claim 7 has been canceled without prejudice and request that the rejection be withdrawn.

Patentability of new Claim 19

New Claim 19 recites “providing a tracking equalizer signal that shows an error between a focus position of the optical beam and a target track position after phase compensation; generating a periodic signal that has a constant period; generating an averaged equalizer signal based on said tracking equalizer signal; and generating a drive signal for controlling said carriage device based on at least a periodic sample of the averaged equalizer signal and at least a periodic sample of the periodic signal.” Applicants submit that at least some of these features are not disclosed by the prior art. Support for the new Claim 19 can at least be found in the originally submitted Claim 1 and Figures 2 and 4.

Hence, Claim 19 is patentable and should be allowed by the Examiner. Claims 20-25, at least based on their dependency on Claim 19, are also believed to be patentable.

Conclusion

In view of the above, reconsideration and allowance of all the claims are respectfully solicited.

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 12-0415. In particular, if this response is not timely filed, then the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136 (a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 12-0415.

I hereby certify that this correspondence is being deposited with the United States Post Office with sufficient postage as first class mail in an envelope addressed to Commissioner for Patents POB 1450, Alexandria, VA 22313-1450 on

June 17, 2005
(Date of Deposit)

Susan Papp
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Respectfully submitted,



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